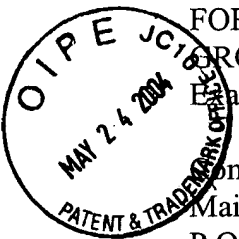


1653



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

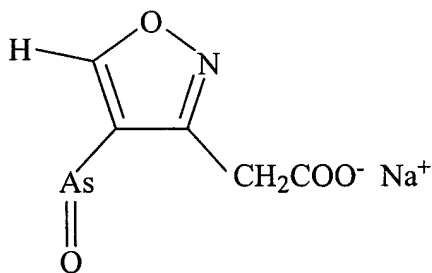
APPLICANT(S) : Rogelj, et al.
SERIAL NO. : 10/002,698
FILED : December 5, 2001
FOR : Inhibition of Cell Surface Protein Disulfide Isomerase
GROUP ART UNIT : 1653
Examiner : David Lukton



Commissioner for Patents
Mail Stop Non-Fee Response
P.O. Box 1450
Alexandria, Virginia 22313-1450

Response to Office Action/Restriction Requirement of April 23, 2004

In response to the Examiner's correspondence dated April 23, 2004, pursuant to the Examiner's continued requirement for electing a single species in the above-referenced patent application, Applicants request that the Examiner allow them to retract their previous election and instead, provisionally elect with traverse to prosecute the invention of group 1, consisting of claims 9-11 and 20 which are directed to compounds exhibiting a common pharmacological utility (PDI inhibition). In addition, Applicants provisionally elect the single species as set forth below.



Claims 9 and 20 are readable thereon. Noted here is the fact that Applicants, by virtue of electing to prosecute the above-species understand that the corresponding method-of-use claims,

Restriction Requirement-Species Restriction -1-
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to the extent they are found to be allowable, would be rejoined herewith.

Notwithstanding Applicants' election, Applicant respectfully traverses the Examiner's requirement for restriction and for requiring the election of a single species. Applicant respectfully requests the Examiner reconsider his restriction requirement. Applicant respectfully submits that prosecution of all of the originally filed claims should not be restricted to the elected invention, for the reasons which are set forth hereinbelow.

According to M.P.E.P. §803, restriction by the Examiner of patentably distinct inventions is proper if the claimed inventions are independent and a *serious burden* would be placed on the Examiner if restriction was not required. Applicant respectfully submits that the presentation of all of the originally filed claims would not place such a serious burden on the Examiner as to require restriction. All of the originally filed claims are related, though patentably distinct chemical compounds which are PDI inhibitors and have a common utility as antiviral compounds.

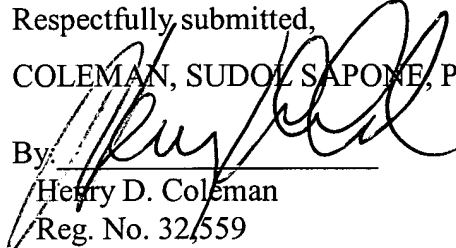
Although the claimed invention groups are generally patentably distinct from each other, Applicant respectfully submits that any search the Examiner would need to conduct in examining the instant application would not be unduly burdensome. Moreover, the examination of all of the originally filed claims in the instant application would not place such a serious burden on the Examiner as to require restriction.

Applicants understand the general policy considerations for the Patent Office's requirement for restriction in certain instances. In this instance, however, those considerations do not weigh in favor of restricting the inventions here. In determining the appropriateness of restriction, one must also consider the countervailing consideration that, in each instance, Applicant wishes the Patent Office to examine his or her application with a certain degree of "administrative efficiency" and wishes to have patent claims issue which reflect the breadth of

his or her invention.

Applicants respectfully submit that the originally filed claims are sufficiently narrow to allow the Examiner to determine patentability without being subjected to the serious burden referred to in M.P.E.P. §803. Consequently, Applicant respectfully requests that the Examiner withdraw the restriction requirement in its entirety.

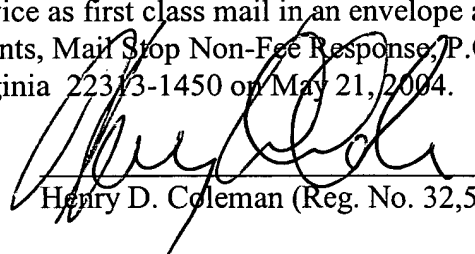
The Examiner is cordially requested to call the undersigned attorney if the Examiner believes that a telephonic discussion may materially advance the prosecution of the instant application in any way. No fee is due for the presentation of this response. A supplemental information disclosure statement is enclosed as are copies of the five cited references.

Respectfully submitted,
COLEMAN, SUDOL SAPONE, P.C.
By: 
Henry D. Coleman
Reg. No. 32,559
714 Colorado Avenue
Bridgeport, Connecticut
(212) 679-0090

Dated: May 21, 2004

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner of Patents, Mail Stop Non-Fee Response, P.O. Box 1450, Alexandria, Virginia 22313-1450 on May 21, 2004.


Henry D. Coleman (Reg. No. 32,559)